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10/663,776	09/17/2003	Byung K. Yi	2101-3239D1	2956

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EXAMINER

DIEP, NHON THANH

ART UNIT PAPER NUMBER

2621

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/663,776

Applicant(s)

YI, BYUNG K.

Examiner

Nhon T. Diep

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 63-67, 69-71 and 75-99 is/are pending in the application.
- 4a) Of the above claim(s) 63, 69-71, 80-89 and 98 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 75-79, 90-97 and 99 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/17/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 11/26/2007 have been fully considered but they are not persuasive.

With regard to the applicant's argument that "the Examiner formally acknowledge the Applicant's claim for foreign priority under 35 U.S.C. § 119 and receipt of the certified copy of the priority document in parent application Set. No. 10/252,412.". The examiner reviewed the file of the mentioned application and could not find any claim of foreign priority, please provide additional information so the matter could be resolved.

With regard to the applicant's argument that "the Examiner appears to have considered an incorrect version of independent claim 75, the text indicated in brackets having been deleted from the claim by virtue of the Supplemental Preliminary Amendment submitted on September 22, 2006.". The examiner made typo error when rewriting the claim, however, he did consider claims as per the Supplemental Preliminary Amendment submitted on September 22, 2006.

With regard to the applicant's argument that "a virtual image created by the receiving party is pre-stored in a receiving party terminal and that the pre-stored image is based on at least one of the receiving party's prior knowledge of a calling party and the receiving party's own perception of the calling party. It is respectfully submitted that Hsu fails to disclose a virtual image created by the receiving party is pre-stored in a receiving party terminal and that the pre-stored image is based on at least one of the receiving party's prior knowledge of a calling party and the receiving party's own

perception of the calling party.", or "the calling party may define the image to be associated with their Caller ID" and that the "calling party transmits an image ... prior to, or concurrently with, a telephone call intended to be answered by the receiving party" and that "image is stored in ... the receiving party's telephone system along with an indication of the Caller ID of the calling party" such that the "next time the calling party calls the receiving party, the previously stored image is accessed and displayed." See Hsu at col. 2, ll. 14-23 (emphasis added). It is respectfully submitted that the disclosure in Hsu does not support the Examiner's assertions." Or "that Hsu does not disclose a virtual image created by the receiving party is stored in the receiving party terminal, as recited in independent claim 75, but rather discloses that an image defined by "the calling party" is transmitted to and stored in "the receiving party's telephone system." It is further respectfully submitted that Hsu fails to disclose that the pre-stored image is based on at least one of the receiving party's prior knowledge of a calling party and the receiving party's own perception of the calling party, but rather discloses that the image is "associated with [the calling party's] Caller ID" and that the image is transmitted either "prior to" or "concurrently with" a telephone call to the "receiving party" and stored in the "receiving party's" telephone system with an "indication of the Caller ID of the calling party" or, in other words, that the "receiving party's" prior knowledge of a calling party and the "receiving party's" own perception of the calling party is not a consideration in the "image" that is "associated with [the calling party's] Caller ID." (page 10, ln. 8 – page 11, ln. 7). And with regard to the applicant's argument concerning claims 94-95 that "Lev fails to cure the deficiencies of Hsu with regard to a virtual image created by the

receiving party is pre-stored in a receiving party terminal and that the pre-stored image is based on at least one of the receiving party's prior knowledge of a calling party and the receiving party's own perception of the calling party, as recited in independent claim 75.

The examiner partially agrees with the applicant's arguments, however, Hsu further discloses that the user of the system (receiving party) can make other refinements to the display and processing of the image icon and that additional information in the forms of images, text, numbers, etc can be provided with the display of the image icon (col. 6, ln. 30-43). Because of that, it is respectfully submitted that at the very beginning, image is defined by the calling party and stored and the receiving party, later can make other refinements to alter the image as stored and any calls after that the refinement pre-stored image is displayed and this image is considered created at least partially by the receiving party. It is further submitted that the claim as of now does not preclude that the image displayed is entirely created by the receiving party, therefore, the rejection is still proper.

With regard to the applicant's argument that "the rejection of claim 93, it is respectfully noted that the Examiner asserts, at paragraph 5 on page 5 of the Office Action, that Hsu discloses "the receiving party selects the at least one format for transmitting the media information" at col. 3, ll. 2-6 and col. 4, ln. 54-63 and specifically cites the "still image" disclosed in Hsu (emphasis added). It is further respectfully noted that the Examiner, with respect to claim 99, asserts the same disclosure in Hsu, specifically col. 3, ln.. 2-6 and col. 4, ll. 54- 63 and the "still image," as disclosing "the

calling party selects the at least one format for transmitting the media information" (emphasis added). It is respectfully submitted that the disclosure in Hsu cannot be interpreted as analogous to both the "receiving" and the "calling" party "selects the at least one format for transmitting the media information." And that "Videophone 280 also receives composite video information from, e.g., external video cameras at 282" and that "Videophone 280 transfers information to desktop PC 284, notebook PC 286 and personal digital assistant (PDA) 288." See Hsu at col. 4, ll. 57-61. and "the disclosure in Hsu is that "Still camera 290 transfers picture information to the desktop PC, notebook PC and PDA." See Hsu at col. 4, ln. 61-63. and that the proper interpretation of the cited portion of Hsu is that the "Videophone 280," "external video cameras at 282" and "still camera 290" in FIG. 4 of Hsu are located at the "calling party" and the "information" is transferred to a "desktop PC 284, notebook PC 286 and personal digital assistant (PDA) 288" that are located at the "receiving party." In support of the Applicant's submitted interpretation of Hsu, the Examiner's attention is respectfully directed to the aforementioned disclosure at col. 2, ln. 14-23 of Hsu that it is the "calling party" that defines the "image" that is "associated with their Caller ID" and it is the "calling party" that transmits the "image" to the "receiving party" as well as to col. 5, ln. 13-55 of Hsu, which discloses that "the operations of image capture 350 ... are performed at the transmitting end ... performed by components at the sending, or calling party's end." Moreover, it is respectfully submitted that there is no disclosure in Hsu of any selection by the receiving party of any format for transmitting the media information, as recited in claim 93."

The examiner respectfully disagrees, column 4, lines 54-64 discloses Videophone 280 also receives composite video information from, e.g. external video camera (claim 99: calling party selects at least one format for transmitting of the media information) and Videophone transfer information to desktop PC, notebook PC and PDA (claim 93: receiving party selects at least one format for transmitting the media information) and it is further noted that claim 99 does not specifically recite any starting and ending point from which the receiving party selects and transmit the at least one format, it is submitted that the receiving party does select at least one format for transmitting the media information from videophone to any of the desktop PC 284, notebook PC 286 and personal digital assistant (PDA).

With regard to the applicant's argument that "the Examiner, at paragraph 7 on pages 5-6 of the Office Action, indicates that Hsu does not disclose that "an identification of the selected at least one format for transmitting the media information is stored in association with calling party identification information, and determined at the receiving party terminal" as recited in claim 92. It is further respectfully noted that the Examiner further asserts that "Hsu teaches many formats for transferring data as [conforming] to ITU-T standards including H.320, H.323, H.324, and T.120 and in some instances, composite video information from external cameras and still camera images are wirelessly transferred" and that "it would have been obvious that any chosen format of the calling party for transmitting the media information to the receiving party must be agreed in advance by both parties." (emphasis added). Applicant respectfully disagrees with the Examiner's interpretation of Hsu. As previously respectfully submitted with

regard to the rejection of claim 93, Hsu discloses that it is the "calling party" that transmits the "image" to the "receiving party." Therefore, it is respectfully submitted that the disclosure in Hsu related to the asserted "many formats for transferring data as [conforming] to ITU-T standards" is with respect to the "calling party" defining the format and is not analogous to the at least one format for transmitting the media information being determined at the receiving party terminal, as recited in claim 92. It is further respectfully submitted that the Examiner's own interpretation is that Hsu discloses a "chosen format of the calling party", which is contrary to the recitation of determined at the receiving party terminal in claim 92.

Again, the examiner respectfully disagrees, it is the examiner opinion that any selected format for transmitting determined by the calling party needs to be comparable with the capability of the receiving party, otherwise, media information transmitted from the calling party would not be able to reach the receiving party and that means determined at the receiving party terminal as broadly interpreted by the examiner.

Having answered all of the applicant's argument, the examiner maintains all of his rejections as set forth in the previous Office Action and repeat as follows:

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 75-79, 90-91, 93, 96 and 99 are rejected under 35 U.S.C. 102(b) as being anticipated by Hsu (US 5,907,604 (cited by the applicant)).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 92 and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu.

6. Claims 94-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu, in view of Lev et al (US 5,987,327).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nhon T. Diep whose telephone number is 571-272-7328. The examiner can normally be reached on m-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mehrdad Dastouri can be reached on 571-272-7418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ND



NHON DIEP
PRIMARY EXAMINER